

## REMARKS

### The Invention

In general, the invention features nucleic acids encoding a baculovirus inhibitor of apoptosis repeat (BIR) domain, and vectors and cells containing such nucleic acids.

### The Office Action

Claim 50, the sole claim, stands rejected under 35 U.S.C. § 112, first paragraph, as lacking an adequate written description and lacking enablement. Claim 50 further stands rejected under 35 U.S.C. § 101 for double patenting in view of U.S. Patent No. 6,156,535. Finally, claim 50 stands objected to for inclusion of non-elected subject matter. Applicants address each of these issues below.

### Support for the Amendments

Claim 50 has been amended to clarify that the claimed nucleic acids comprise SEQ ID NO: 47 or 51, which encode XIAP BIR3 domains. New claims 79-84 are directed to vectors or cells containing such nucleic acids. Support for these claims is found, for example, at page 29, line 23, to page 30, line 15. New claims 85-90 are directed to nucleic acids encoding XIAP BIR3 domains. Support for these claims is also found at page 29, line 23, to page 30, line 15, as well as in Table 2 and Fig. 7. No new matter has been added.

### Restriction Requirement

Applicants thank the Office for reconsidering the restriction requirement and electing to consider SEQ ID NOs: 47 and 51 together. Applicants note that new claims 85-92 are directed

to nucleic acids encoding one of SEQ ID NO: 24 and 25, which correspond to human and mouse XIAP BIR3. These BIR domains are encoded by SEQ ID NOs: 47 and 51, among others, and thus consideration of these claims is respectfully requested.

#### Objection to claim 50

Claim 50 is objected to for inclusion of non-elected subject matter. Applicants have amended claim 50 to recite only to SEQ ID NOs: 47 and 51, and this objection may be withdrawn.

#### Rejection under 35 U.S.C. § 101

Claim 50 is rejected for statutory-type double patenting in view of claim 7 of U.S. Patent No. 6,156,535. Applicants have amended claim 50 so that it is no longer coextensive in scope with claim 7, and this rejection may now be withdrawn.

#### Rejection under 35 U.S.C. § 112, first paragraph

Claim 50 is rejected for lacking an adequate written description and lacking enablement. The basis for each of these rejections is in the interpretation of the scope of claim 50. The Office asserts that claim 50 as examined, when given the broadest interpretation, “encompasses a nucleotide sequence which encodes any and all BIR domains...in addition to [the] nucleic acid sequence of SEQ ID NO: 47 or 51.” Applicants have amended claim 50 to recite that the BIR domain comprises the sequence of SEQ ID NO: 47 or 51. The Office acknowledges that the specification is “enabling for a nucleic acid sequence encoding a BIR domain wherein the BIR domain comprises a nucleic acid sequence selected from the group consisting of SEQ ID NO: 47

and 51" (i.e., a nucleic acid as claimed in amended claim 50), and, accordingly, the enablement rejection may now be withdrawn. As for the written description rejection, applicants submit that this rejection has also been overcome by the amendment of claim 50. As stated above, the Office's issue with claim 50 pertained to the scope of this claim; this issue has been addressed by the present amendment, and withdrawal of the rejection of claim 50 under 35 U.S.C. § 112, first paragraph, is respectfully requested.

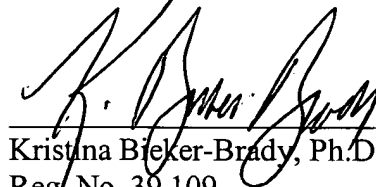
### CONCLUSION

Applicants submit that the claims are now in condition for allowance and such action is respectfully requested. Enclosed is a petition to extend the period for replying for three months, to and including November 8, 2003. If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date:

November 10, 2003

  
\_\_\_\_\_  
Kristina Bieker-Brady, Ph.D.  
Reg. No. 39,109

Clark & Elbing LLP  
101 Federal Street  
Boston, MA 02110  
Telephone: 617-428-0200  
Facsimile: 617-428-7045